



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,070	12/07/2000	Max Hamberg	4925-98PUS	4634

27799 7590 10/06/2003

COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
----------	--------------

2683

8

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,070

Applicant(s)

HAMBERG, MAX

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

This application **does not contain an abstract** of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application **should include the following sections in order**. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Drawings

New corrected drawings are required in this application because:

1) they have markings on them not pertinent to this case (eg. "PCT/FI99/0562" is written on them and should be removed).

2) the boxes of the drawings should be labeled with words instead of just numbers.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Information Disclosure Statement

1. The information disclosure statement filed December 7th, 2000 fails to comply with 37 CFR 1.98(a)(1), **which requires a list** of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. **There is a group of patents and other literature in the application that may be associated with the IDS (a few of the patent numbers are US3949404, US4495619, US5297144, US5420851, etc.). These patents were not considered.**

2. The IDS submitted for the Translation of the Finnish Official Action does not have a PTO-1449 form to sign which lists said document for the examiner to sign. It has been considered.

Claim Objections

Claims 19 and 20 objected to because of the following informalities: These two claims do not refer back to the independent claim to which they are placed under (eg. they refer to claim 12, yet claim 13 is the independent claim they are placed under). The examiner believes they actually refer back to claim 13 – if this is NOT correct, then claims 19 and 20 should have been dependent claims 13 and 14 (and currently independent claim 13 should have been claim 15). Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Widegren et al. WO97/34437 and further in view of Veloso US 6,122,508 (hereafter Widegren and Veloso).

As per **claims 1, 13 and 20**, Widegren teaches a method for connecting a system comprising a subscriber apparatus to a mobile network (figure 1) characterized by:

Storing in a network element connected to the mobile network subscriber
Emulating towards said mobile network a desired interface of said mobile
network

Emulating towards said system a desired interface of said system

Connecting signals of said system to the mobile network and signals of the mobile to said system (abstract, figure 1 - WO gateway and page 6, L8-37 to page 7, L1-21)

But is silent on use of a SIM card/memory means (eg. information corresponding to information in a subscriber identity module of a mobile network means of the mobile network).

The examiner notes that the use of SIM cards is well known in GSM mobile networks AND **Veloso** teaches a mobile radio system with wireline subscriber terminals with card reading devices (for reading authorization cards (SIM)) that can connect to a wireless system (abstract and figure 1). Widegren also teaches that the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features (page 7, L22-36 to page 8, L1-11).

The examiner also notes (but does not cite), per the enclosed written opinion, that Robert (WO9533348) has teachings which read on the claimed invention (as does Bales and Brunner).

With further regard to claim 13, the examiner interprets the emulation and switching blocks as disclosed in Widegren (figure 1, WO gateway and page 7, L4-21).

It would have been obvious to one skilled in the art at the time of the invention to modify Widegren, such that SIM card data can be stored by the element/gateway, to provide support to any/all phone that use SIM cards and for central storage of SIM data.

As per **claims 2 and 14**, Widegren teaches claim 1/13 wherein the network element is used to emulate mobile network functions associated with mobile devices that are not realized by the subscriber apparatus in said system (page 7, L4-22 teaches the WO gateway which is hardware/software implementation that provides interface between wired and wireless users and would contain memory/database and Widegren also teaches that the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features (page 7, L22-36 to page 8, L1-11).

Widegren also teaches HLR/VLR functionality/databases (figure 2, #210/#212).

As per **claim 3**, Widegren teaches claim 2 **but is silent on** wherein at least part of said functions are functions dependent on subscriber information.

The examiner notes that the WO Gateway can provide various "internal" call functions (page 8, L3-11) and the subscriber database taught by Widegren can contain virtually any type of data AND **Veloso** teaches a mobile radio system with wireline subscriber terminals with card reading devices (for reading authorization cards (SIM)) that can connect to a wireless system (abstract and figure 1). Widegren also teaches that the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide special internal special services and features (page 7, L22-36 to page 8, L1-11) which can be dependent upon each subscriber's individual call information since different people in the company would have different subscriber profiles (eg. compare the CEO to a manager to a regular worker).

It would have been obvious to one skilled in the art at the time of the invention to modify Widegren, such that part of the functions are dependent upon subscriber information, to provide means for the phone system to provide the correct functions to each individual user based on their profile/subscriber information.

As per **claim 4**, Widegren teaches claim 1 characterized in that the network element is used to receive signals from said system, which signals are coming from signal lines of which there are a certain first number, and received signals are connected into signal lines of the mobile network of which there are a certain second number such that the second number is smaller than said first number (figure 1 shows the WO Gateway #124 connected to various systems, such as the RAN, MSC and Int/Ext ACC's – the use or non-use of multiplexing on any of these links would decrease or increase the number of signal lines required between the systems). One skilled in the art would provide multiplexing where convenient and cost effective to carry multiple connections over one physical link (ref. Widegren's reference to ISDN, page 7, L19-21).

As per **claims 5-7 and 16-18**, Widegren teaches claim 1/15 the WO Gateway can be located at various locations (page 7, L10-12) and one skilled in the art would locate it between BSC and MSC, between BSC and BTS or between mobile and BTS.

As per **claim 8**, Widegren teaches claim 1 in that at least part of the mobile subscriber data needed by the network element is read from a database stored in the network element (figure 1, WO Gateway also comprises HLR/VLR functionality/databases, #210/#212).

As per **claim 9**, Widegren teaches claim 1 in that at least part of the mobile subscriber data needed by the network element is generated automatically (figure 1, WO Gateway also comprises HLR/VLR functionality/databases, #210/#212, which are updated automatically as the mobile user roams. Other functions may be updated by a system administrator should a user's subscriber profile change per page 8, L3-7).

As per **claims 10-12**, Widegren teaches claim 1 and that mobile-to-mobile, fixed-to-fixed, fixed-to-mobile and mobile/fixed (private)-to-fixed/mobile (public) calls can be connected by the system (abstract and figure 1).

As per **claim 15**, Widegren teaches claim 13 and emulation/output blocks for realizing functionality according to a predetermined interface of said mobile network (figure 1 shows WO Gateway with input/output connections and emulation, page 7, L4-21).

As per **claim 19**, Widegren teaches claim 13 and that it comprises a database block for storing mobile network subscription data corresponding to subscriber apparatus in said system (WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features, page 7, L22-36 to page 8, L1-11) as well as provide HLR and VLR functions/databases (figure 2, #210/#212).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Malmstrom US 5,901,359 teaches wireline-to-wireless network interface
2. McHenry et al. US 5,592,533 teaches PCS registration system.
3. Khan et al. US 5,745,852 teaches land-line supported private BTS.
4. Kennedy III et al. US 5,734,981 teaches call delivery to mobile unit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7493 for regular communications and 703-746-7493 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SMD 
9-25-07


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600